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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/665,760      | 09/20/2000  | Ulrich Priesnitz     | GR 98 P 1397 P      | 8661             |

21495 7590 11/24/2003

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EXAMINER

DYE, RENA

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3627

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/665,760

Applicant(s)

PRIESNITZ ET AL.

Examiner

Rena L. Dye

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 14, 2013 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In claims 1 and 13, the expression "by melting an irradiated region, thereby forming a foamlike CO<sub>2</sub> region that scatters incident light" is not clearly supported by the present specification, therefore, constituting new matter. In Applicant's next response, the Examiner would like to request that Applicant point to where clear support can be found.

Art Unit: 3627

4. Claims 5-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In claims 5-9 the term "about" is not clearly defined in the present specification.

Applicant appears to be slightly broadening the ranges, such that the endpoints of the claims ranges are not clearly supported or defined by the present specification.

The specification, page 5, lines 6-16 states the following:

*...the carbon content in the second layer is in a range from 0.2 to 0.8% by weight, and particularly from 0.2 to 0.5% by weight, and the thickness of the second layer is in a range from 0.01 to 1.0 mm, particularly from 0.05 to 0.2 mm In accordance with a further feature of the invention, the proportion of the carbon material in the first layer is in a range from 1 to 3% by weight.*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3627

In claims 5-9, line 3, the use of “about” language is indefinite because it is not exactly clear what range “about” would encompass. Applicant appears to be attempting to broaden the ranges; however, the range is not clearly defined in the claims or the present specification.

6. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, the expression “bounding an exterior” is vague and unclear. Does Applicant mean that the second layer is exterior to the first layer and is exposed to that exterior of the sheathing? Clarification is requested.

In claim 1, line 7, the expression “containing, at least inside said marking face, a second proportion of the dye” is unclear. How is the dye contained within the marking face? Is it blended within a resin, or coated onto the exterior of the sheathing? How is the dye contained? Clarification is requested.

In claim 1, line 9, the expression “dye associated with said second layer dimensioned to cause a color change upon irradiation with photons..” is vague and unclear. The term “dimensioned” is typically used when defining a size or shape. In the context used, it is not clear how the dye is situated with respect to the second layer so that the dye changes color upon irradiation with photons. Clarification is requested.

Art Unit: 3627

7. Claims 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, line 7, “a dimension of said exterior layer selected from the group consisting of a thickness of the exterior layer and the proportion of said dye being selected...” is confusing. With respect to the term “dimension, in the context used, it is not clear how the dye is situated with respect to the exterior layer so that the dye changes color upon irradiation with photons. Clarification is requested.

8. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 13, line 12, the term “foamlike” is vague and indefinite. How is the melted, irradiated region like a foam? Is it merely textured to appear like foam? If the sheathing is foamed by e.g. bubbling, a better term would include “foamed” or a process limitation such as “foaming has occurred”.

In claims 1 and 13, line 12, the term “foamlike CO<sub>2</sub> region” is indefinite. It is not exactly clear what is being claimed. Is Applicant referring to foamed cells that contain CO<sub>2</sub>? Where does the CO<sub>2</sub> come from? Does the CO<sub>2</sub> come from within the sheathing material upon being irradiated? Is the sheathing irradiated in a CO<sub>2</sub> environment? Clarification is requested.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,3,10,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler (US 4,865,198).

Butler teaches a sheathing article or overwrapping packaging material comprising an external layer of flexible transparent or translucent overwrap plastic film. In all embodiments of the invention the overwrap film must have sufficient transparency or translucency so that a pattern disposed on its inner surface is visible through the film. Preferred films include single or multiple layer films comprising polyolefins (thermoplastic material). The chemical nature of the film is not critical as long as it (1) has sufficient film integrity for its intended protective use, (2) provides a surface having appropriate ink affinity characteristics, and (3) is essentially transparent, or sufficiently conductive with respect to the energy source used to vaporize or activate the underlying coating or pigments. With appropriate selection of energy type and level, wavelength and the link, the process is amenable to any of the optically transparent overwrap films used commercially (column 2, lines 12-39). The overwrapped package includes a package of substrate 3 which can be constructed from any suitable packaging material such as paper, metal, glass, plastic or the like with a heat-labile ink, pigment or adhesive coating 4. The heat-labile ink can be any ink that can be vaporized by an energy source such as light provided

Art Unit: 3627

from a pulsed laser. The ink can be thermotropic in nature so that direct heat application causes a change in color (column 2, lines 40-55).

Butler fails to specifically teach a dye provided in both the first and second layers. It would have been obvious to one having ordinary skill in the art to have provided dye in both layers or either layer by itself to have provided the overwrapping package material with a preferred design choice. The first and second layers being formed of the same material are within the scope of the teachings of the reference.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-9 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler (US 4,865,198) in view of Bonkowski et al. (US 6,031,457).

Butler has been previously discussed and fails to specifically teach graphite as the dye material.

Bonkowski teaches a substrate layer or film which can be printed using a laser or other types of printers. The printing can be composed of any printing materials such as paint, ink or graphite compositions (column 5, lines 19-57).

Since Bonkowski teaches that graphite is a known dye or ink for use in printing with a laser, it would have been obvious to one having ordinary skill in the art to have used graphite in



Art Unit: 3627

the ink or pigment layer of Butler. The proportion of dye in each of the layers would have been an obvious design choice based upon the desired visual appearance.

With respect to thickness, one having ordinary skill in the art would have known how to have varied the thickness based upon the desired degree of strength and barrier property.

***Response to Arguments***

11. Applicant's arguments filed on August 14, 2003 have been fully considered but they are not persuasive.

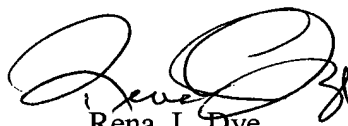
Applicant's arguments have been carefully considered; however, in view of the indefiniteness of the present claims, the art rejections of record have been maintained.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rena L. Dye whose telephone number is 703-308-4331. The examiner can normally be reached on Monday-Thursday 8:30 AM - 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Art Unit: 3627

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

A handwritten signature in black ink, appearing to read 'Rena L. Dye', with a stylized flourish at the end.

Rena L. Dye  
Primary Examiner  
Art Unit 3627

R. Dye  
11/20/03